

GEVORGIAN, S. et al.  
Serial No. 10/781,930

Atty Dkt: 4127-13  
Art Unit: 2817

### **REMARKS/ARGUMENTS**

Reexamination of the captioned application is respectfully requested.

#### **A. SUMMARY OF THIS AMENDMENT**

By the current amendment, Applicants basically:

1. Editorially amend the specification.
2. Editorially amend all claims.
3. Address the incorporation by reference aspects of the Office Action (see section B infra).
4. Respectfully traverse all prior art rejections.
5. Advise the Examiner of the simultaneous filing of a Petition to Extend.
6. Request that the Examiner officially cite and consider documents listed on the attached PTO 1449.

#### **B. THE INCORPORATION BY REFERENCE**

Requirement is made on page 3 of the Office Action to amend the disclosure to include subject matter of three documents. As a preliminary matter, Applicants believe there is no basis to require Applicants to amend the disclosure to include incorporated material when there is no explanation in the office action why the incorporated material is believed to be essential material.

The first document, Gevorgian et al., "Low order modes of YBCO/STO/YBCO circular disk resonators", IEEE Trans. Microwave Theory and Techniques vol. 44, No. 10, Oct. 1996, merely augments the specification's discussion and/or includes further examples of what is adequately explained in enabling fashion in the specification. The requirement to amend Applicants' specification to include the Gevorgian text is therefore unnecessary and improper.

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Without taking a position whether the material disclosed in the two Swedish applications is essential, and as an accommodation, Applicants have amended the specification to incorporate by reference the corresponding US Patents in addition to the already incorporated corresponding Swedish patent applications<sup>1</sup>. In addition, Applicants have amended the last paragraph of page 2 of the specification to incorporate by reference another corresponding US patent<sup>2</sup>. Copies of the first pages of the three now-incorporated US patents (6,185,441; 6,187,717, and 6,463,308) are attached.

It is hoped that the incorporation by reference issues raised by the Office Action are now moot.

### C. PATENTABILITY OF THE CLAIMS

Claims 1, 2, 3, 4, 7, 8, 12, 13, 16-20, 21 and 22 stand rejected under 35 USC 102(e) as being clearly anticipated by U.S. Patent 6,463,308 to Wikborg et al. Claims 1, 2, 3, 12, 13, 17-19 and 21 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Patent 5,969,584 to Huang et al in view the Petrove et al reference cited by applications. All prior art rejections are respectfully traversed for at least the following reasons.

The present claims relate to a tunable resonator arrangement comprising two resonators, one tunable, the other not, but which operates as a single resonator. The resonant frequency of the tunable resonators differs significantly from that of the non-tunable resonator and hence at the frequency of interest acts as a reactance. Such is absolutely clear e.g. from Fig. 12 of the present application wherein a two-pole filter is

<sup>1</sup> The SE patent application 9701450-0 (page 16, line 10) has a US corresponding application: 6,185,441 (09/061,272) and SE application 9502137-4 (page 21, line 1 and page 2, line 29), corresponds to US patent No. 6,463,308 which is the patent cited by the Examiner as the first reference.

<sup>2</sup> US 6,187,717 (08/985,149) corresponds to SE 9502138-2.

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shown (page 21, last paragraph) while it formally contains four resonators, two which are tunable and two which are non-tunable.

Independent claims 1 and 21 have been amended to reflect the fact that the resonator apparatus provides a two pole filter. Support for the amendatory language resides throughout the original disclosure, including (for example) Fig. 11 – Fig. 13 and the descriptions thereof.

The claimed subject matter thus contrasts significantly with US-6,463,308. The 308 patent shows (Fig. 12) a three-pole filter, wherein all three resonators have close resonance frequencies so that a three pole filter is formed. Thus, the applied reference is misapprehended and inappropriate for rejecting Applicants' claims.

In Huang, tunable and non-tunable resonators have similar resonant frequency. By contrast, and as referred to above, according to Applicants' claims the resonant frequencies of the tunable/resonator has a resonant frequency differing significantly from that of the non-tunable one, and in the frequency range of interest works as a reactance.

#### D. INFORMATION DISCLOSURE

Applicants request that the Examiner consider and cite the US patents which are listed on the attached PTO-1449, and return an initialed copy of the PTO-1449 to the undersigned.

#### E. MISCELLANEOUS

In view of the foregoing and other considerations, all claims are deemed in condition for allowance. A formal indication of allowability is earnestly solicited.

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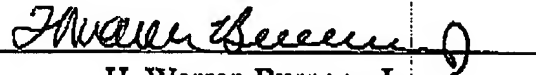
The Commissioner is authorized to charge the undersigned's deposit account #14-1140 in whatever amount is necessary for entry of these papers and the continued pendency of the captioned application.

Should the Examiner feel that an interview with the undersigned would facilitate allowance of this application, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By:



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